

REMARKS

Status of the Claims

Claims 1-4, 6-10, 12-19, 21-24, 35-40, and 65-74 are presently pending in this application. Consideration of claims 1-4, 6-10, 13-19, 21-24, 35-40, and 65-74 and new claims 75-77 is respectfully requested.

Amendments to the Claims

Claim 73 is amended to recite that the guide member has first and second bores formed *within a single lumen*. Support for this amendment can be found throughout the specification, for example in paragraph [0046] of the published application.

New independent claim 75 includes the limitations of claims 65 (as amended in the Response to the first Office Action filed on May 11, 2006) and 67-69. New independent claim 76 includes the limitations of claims 65 (as amended in the Response to the first Office Action filed on May 11, 2006) and 70-72.

No new matter is added.

Rejections Pursuant to 35 U.S.C. § 102

Claims 1-4, 9, 10, 17-19, 35, and 65

Claims 1-4, 9, 10, 17-19, 35, and 65 are rejected pursuant to 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0015174 A1 of Null et al. ("Null"). Applicant respectfully disagrees.

Independent claim 1 recites an elongate shaft having a proximal end and a distal end, the proximal end of the shaft being positioned at an angle other than 0 with respect to the distal end of the shaft. Claim 1 also recites a guide member coupled to the distal end of the elongate shaft and including first and second pathways at least partially in communication with one another and extending therethrough in a fixed relation to one another. The distal end of the elongate shaft is offset from the first and second pathways. Claim 1 further recites at least one alignment element positioned distal of the guide member, the at least one alignment element being adapted to interact

with a spinal fixation element to position the guide member with respect to the spinal fixation element such that the first and second pathways in the guide member are aligned with a pair of corresponding thru bores formed in the spinal fixation element.

Null does not teach or suggest a guide member including first and second pathways at least partially in communication with one another and extending therethrough. The Examiner asserts that the pathways (30, 31) in Null are at least partially in communication with one another because they are touching each other. However, there is no indication in the specification or drawings of Null that the pathways (30, 31) do touch each other. The pathways (30, 31) are shown clearly spaced apart from each other in FIGS. 2, 4, 7, and 8, with guide member engagement portion (49) obscuring the only possible touching point. Furthermore, as set forth in the dictionary, and as is generally understood, "communication" means a "passage, or an opportunity or means of passage, between places." (www.dictionary.com). Thus, even if the outer surfaces of the guide member could be considered to be in contact with one another, the *pathways* (30, 31) extending through the guide members do not have any passage extending between them. Rather, they are separate and distinct from one another. Null therefore fails to teach a guide member including first and second pathways at least partially in communication with one another and extending therethrough. Accordingly, independent claim 1, as well as claims 2-4, 9, 10, 17-19 which depend therefrom, distinguish over Null and represent allowable subject matter.

Independent claims 35 and 65 also recite pathways being at least partially in communication with each other and extending through a guide member, so claims 35 and 65 distinguish over Null for at least the reasons discussed for claim 1.

Claims 1, 35, 36-40, 65, 73, and 74

Claims 1, 35, 36-40, 65, 73, and 74 are also rejected pursuant to 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0092947 A1 of Foley ("Foley"). Applicant respectfully disagrees.

Foley does not teach or suggest pathways being at least partially in communication with each other as is recited in independent claims 1, 35, 65, and 74. The Examiner asserts that in Foley, the pathways (26, 66) are at least partially in communication with each other by a connecting member (41). However, as explained above, in "communication" means a passage. While the guide

members are connected to one another by a solid connecting member (41), as can clearly be seen in FIGS. 2-5, the *pathways* (26, 66) within the guide members of Foley are separate and distinct from one another. Accordingly, independent claims 1, 35, 65, and 74, as well as claims 36-40 which depend from claim 35, distinguish over Foley and represent allowable subject matter.

Claim 73

Independent claim 73 recites an elongate shaft having proximal and distal ends. The proximal end of the shaft is positioned at an angle other than 0 with respect to the distal end of the shaft. Claim 73 further recites a guide member coupled to the distal end of the elongate shaft and adapted to be juxtaposed on a spinal fixation element having first and second thru bores formed within a single lumen. The guide member includes a first substantially C-shaped lateral sidewall for guiding implants, tools, and devices through the first thru bore in the spinal fixation element, and a second, opposed substantially C-shaped lateral sidewall for guiding implants, tools, and devices through the second thru bore in the spinal fixation element.

Foley does not teach or suggest a guide member having first and second thru bores formed within a single lumen and C-shaped sidewalls for guiding implants, tools, and devices through the thru bores. As explained above, in Foley, the pathways (26, 66) are separate and distinct and therefore are not formed within a single lumen. Accordingly, independent claim 73 distinguishes over Foley and represents allowable subject matter.

New Claims 75 and 76

Applicant thanks the Examiner for indicating that claims 6-8, 12-16, 21-24 and 66-72 would be allowable if rewritten in independent form. In all Office Actions subsequent to the first Office Action, the Examiner indicated that dependent claims 69 and 72 represent allowable subject matter and that these claims would be allowed if amended into independent format to include all of the limitations of the base claim and any intervening claims. Accordingly, Applicants add new claim 75, which includes all of the limitations of claims 65 (as amended in the Response to the first Office Action filed on May 11, 2006), 67, 68, and 69. Claim 75 is therefore in condition for allowance. Applicants also add new claim 76, which includes all of the limitations of claims 65 (as amended in the Response to the first Office Action filed on May 11, 2006), 70, 71, and 72. Claim 76 is therefore


in condition for allowance. Accordingly, Applicant respectfully requests allowance of new claims 75-76.

Conclusion

Applicant submits that all claims are in condition for allowance for at least the reasons discussed above, and allowance thereof is respectfully requested. The Examiner is encouraged to telephone the undersigned attorney for Applicant if such communication is deemed to expedite prosecution of this application.

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Respectfully submitted,

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